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June 21, 2002

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

Re: **Application Serial No.: 09/398,182**  
**Confirmation No.: 9748**  
**Appellants: Alan J. Rozlosnik, et al.**  
**Title: Receipt Delivery System for**  
**Secure Depository**  
**Docket No.: D-1118R2**

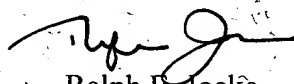
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Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated June 3, 2002, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,



Ralph E. Jocke  
Reg. No. 31,029

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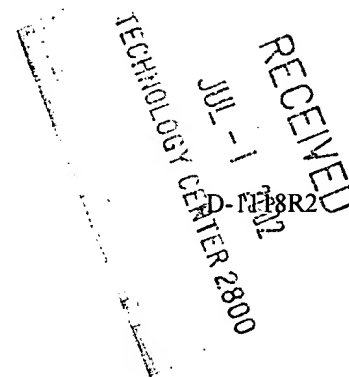
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	)	
Alan J. Rozlosnik, et al.	)	
Serial No.:	)	Art Unit: 2876
09/398,182	)	
Filed:	)	Patent Examiner:
September 17, 1999	)	April A. Nowlin
Title:	)	
Receipt Delivery System	)	
for Secure Depository	)	

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

**REPLY BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.193(b)**

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

**REMARKS**

Appellants filed a Supplemental Appeal Brief ("Brief") on April 5, 2002. The Examiner's Answer ("Answer") dated June 3, 2002 is acknowledged.

### **Grouping of Claims**

The Answer (at page 2) alleges that the Brief "includes a statement that all claims stand or fall together." The Appellants respectfully disagree. The Appeal Brief (at page 6) includes a Grouping of Claims section which states that "Claims 1 and 16 stand or fall together. Each of Appellants' other claims, 2-15 and 17-18 each constitute a separate group." Thus, only claims 1 and 16 stand or fall together. Claims 2-15 and 17-18 do not stand or fall together with any other claim. The Brief (in the Argument section thereof) also explains why the claims are separately patentable. Even the Answer admits that reasons have been properly provided. Thus, the Brief includes both a proper statement that not all of the claims stand or fall together and presents reasons why the claims are separately patentable. It follows that the Answer incorrectly ascertains the Grouping of Claims section of the Brief.

### **Reply to additional comments in the Answer**

Claims 1-3, 5-8, and 10-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell in view of McCall. Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell in view of McCall and further in view of Imai. These rejections appear to be identical to those set forth in the Final Rejection dated August 13, 2001. Thus, these rejections have already been addressed in the Brief.

The Answer includes a "Response to Argument" section (beginning at page 5) which includes additional comments. Appellants respectfully submit that the issues mentioned in this section have likewise already been addressed in the Brief.

The Answer (at page 6) refers to *In re Scheckler*, 168 USPQ 716 (1971). However, the Office is directed to the following applicable legal standards (which the Office does not meet):

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion that something is basic knowledge and/or common sense that is not based on any evidence in the record lacks substantial evidence support and is not a valid basis for rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

The Answer, at page 6, lines 6-8, regarding references, admits that applicable knowledge must be "clearly present in the prior art." However, as explained in more detail in the Brief, the

rejections are not based on knowledge which is "clearly present in the prior art." For example, the Answer (e.g., page 8) alleges that McCall shows a receipt dispenser having a cover with an aperture. The Appellants respectfully disagree. As discussed in more detail in the Brief, this allegation lacks substantial evidence support. Even the Office has admitted (sentence bridging pages 4 and 5 in the Final Rejection) that McCall does not teach or suggest the recited overlying member for use in delivering a receipt.

The Appellants traverse the Office's interpretation and application of the references. Appellants' Brief provides reasons why all the pending claims are allowable. The Answer only touches on a few of Appellants' many reasons why the claims are allowable. The Answer lacks a showing that it would have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention. The Office has not established a *prima facie* showing of obviousness.

## CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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